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PATENT

Attorney Reference Number 6541-62417-01
Application Number 10/091,047

Remarks

The Applicant respectfully requests reconsideration in view of the following remarks.

Claims 1-4, 6-9 and 11-32 are pending. In the final Office action dated October 19, 2006 ("final Office action"), the Examiner rejects claims 1-4, 6-9 and 11-28 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Application Publication No. 2002/0120749 to Widegren et al. ("Widegren publication"). The Examiner rejects claims 29-32 under 35 U.S.C. § 103 as being unpatentable over the Widegren publication. The Applicant respectfully disagrees with the rejections.

In August 2006, the Applicant, Hugh Shieh, filed a declaration under 37 CFR 1.132, declaring that the Applicants listed on the Widegren publication ("Widegren Applicants") derived their knowledge of some of the subject matter described in the Widegren publication from Mr. Shieh. For that subject matter, the Applicant requested that the Widegren publication be removed as a 102(e) reference.

Addressing the declaration in the final Office action, the Examiner writes:

The Applicants have argued that the concepts and ideas used by the applied reference (Widegren '749 with the provisional application filed on March 6, 2001) were derived from the present Applicant of this application (Shieh). However, these arguments are not persuasive. The reference and the provisional (2002/0120749 and 60/273,678) applied comprise a different inventive entity than the present application. Further, the assignees of the reference in question and the present application are not the same company. Therefore, the Widegren application and the related provisionals are not recognized as being the Applicant's concept at this time, and the Affidavit filed by the Applicant does not call for the withdrawal of the Widegren application in the rejection.

(Final Office action, page 2.)

The present application and the Widegren publication do have different inventive entities and different assignees, but this does not justify the Examiner's treatment of the August 2006 declaration. The MPEP specifically endorses the use of a declaration of attribution when a reference has a different inventive entity (*see* MPEP 716, Example 2), and the Applicant is not attempting to remove the Widegren publication as a prior art reference due to common ownership. The use of a Rule 1.132 declaration is appropriate in this case, despite the fact that the present application and Widegren publication have different inventive entities and different assignees.

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In the final Office action, the Examiner also writes:

Filing an Affidavit. C.F.R. 1.132 was not a proper venue to argue that the ideas and concepts of the reference in question were derived from the Applicant. One proper venue the Applicant may pursue is an Interference.

(*Id.*) Whether or not an interference ever would have been proper, the question is now moot. The Widegren Applicants filed an amendment in October 2006, in the application published as the Widegren publication. In the amendment, the Widegren Applicants acknowledge Mr. Shieh's August 2006 declaration and cancel claims 10-15, 24-31, 38-41 and 43-46 "to avoid any dispute in view of the Rule 1.132 declaration filed in application serial number 10/091,047 to Shieh, filed on March 4, 2002." (Amendment dated October 6, 2006, application serial no. 09/985,573.) The use of a Rule 1.132 declaration, and not an interference, is appropriate in this case.

Mr. Shieh's August 2006 declaration satisfies the requirements for a Rule 1.132 declaration in this context. According to the MPEP:

When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection, which is not a statutory bar, on that patent or publication may be removed by submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based.

(MPEP 715.01(c).) The subject matter in question is currently "unclaimed subject matter" in the application published as the Widegren publication. Moreover, the August 2006 declaration explains how and when the Widegren Applicants derived their knowledge of the subject matter in question from Mr. Shieh. The declaration also explains how Mr. Shieh made the invention upon which the relevant disclosure is based. Finally, the August 2006 declaration has not been contradicted. According to the MPEP, "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, paper, or published application will be accepted as establishing inventorship." (MPEP 716.) The Widegren Applicants acknowledged the August 2006 declaration in their October 2006 amendment, and they did not contradict or dispute the statements in the August 2006 declaration.

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For at least these reasons, for the subject matter derived from Hugh Shieh, the Widegren publication should be removed as a 102(e) reference. Claims 1-4, 6-9 and 11-32 should be allowed.

Interview Summary

The Applicant thanks Examiners Gee and Zand for participating in a telephonic interview with the undersigned attorney on January 11, 2007, and for preparing the Interview Summary dated January 23, 2007. No demonstration was conducted during the interview.

The interview participants discussed the August 2006 declaration as well as sections of the MPEP cited above. The undersigned attorney asked questions about the Examiner's treatment of the August 2006 declaration. The participants discussed the Widegren publication and its parent provisional application no. 60/273,678. The undersigned attorney alerted the Examiners to the claim cancellations and remarks made in the amendment dated October 6, 2006, in U.S. Patent Application No. 09/985,573 (the application published as the Widegren publication). The undersigned attorney requested that the Examiners reconsider their decision about the August 2006 declaration and the Widegren publication.

The Examiners opined that reviewing the August 2006 declaration, the many documents in the file, recent events in the Widegren application 09/985,573, and other parts of the Widegren publication would require further consideration, and the Examiners proposed that the Applicant file an RCE. The undersigned attorney proposed submitting a written response to the final Office action.

Claims 1-4, 6-9 and 11-32 should be allowed. Such action is respectfully requested.

Respectfully submitted,

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